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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SILVERMAN, ERIC E	

ART UNIT	PAPER NUMBER
1618	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/528,835	BLIN ET AL.	
	Examiner	Art Unit	
	ERIC E. SILVERMAN	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *85-88,90,93,95-143 and 145-184* is/are pending in the application.

4a) Of the above claim(s) *101-103,117-134,137-140 and 176-184* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *85-88,90,93,95-100,104-116,135-137 and 141-175* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9-14-09,1-17-08,7-19-06,3-1-06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' response, filed 9/14/2009, is noted. Claims 85-88, 90, 93, 95-143, and 145-184 are pending. Applicants elected Group I, claims 85-175. Further, Applicants' elected a polymer and a gelling agent In the response, Applicants submit that claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 read on the elected polymer, claims 85-88, 90,93, 95-143, and 145-175 read on the elected gelling agent. Claims 101-103, 117-134, 137-140, and176-184 are withdrawn for reading on a non-elected species or non-elected group. Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are treated on the merits, and claims 101-103, 117-134, 137-140, and176-184 are withdrawn, there being no allowable generic or linking claim.

Allowable Subject Matter

The claims would be allowable if the at least one block copolymers were limited to the copolymer with (a) first block that is acrylic acid/isobutyl acrylate, (b) second block is isobornyl acrylate, and (c) an intermediate block that is isobornyl acrylate and either acrylic acid or isobutyl acrylate, or isobornyl acrylate and both acrylic acid and isobutyl acrylate.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the

elected species of block copolymer, does not reasonably provide enablement for any other block copolymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

A claim fails to meet the enablement requirement if an artisan of ordinary skill could not make or use the invention without undue experimentation. Here, the person of ordinary skill could not make the composition as claimed without undue experimentation.

Undue experimentation is considered in light of the factors enumerated in MPEP 2164(a). All of these factors have been considered, and those applicable to this case have been discussed below.

1. The breadth of the claims

The claims read on cosmetic compositions comprising (1) a block polymer, and (2) an organic liquid mediu, the organic liquid medium comprising (3) a non-volatile liquid fatty phase. The block copolymer must be a tri-block copolymer with (a) a first block comprising a monomer, (b) a second block comprising a monomer different from that of the first block, and (c) an intermediate block between the first and second block. The intermediate block must be a random mixture of the monomers of the first and second block. The various blocks of the polymer must conform with specific Tg (glass transition temperature) requirements.

2. The scope of the invention

Applicants have invented a polymer with (a) first block that is acrylic acid/isobutyl acrylate, (b) second block is isobornyl acrylate, and (c) an intermediate block that is isobornyl acrylate and either acrylic acid or isobutyl acrylate, or isobornyl acrylate and both acrylic acid and isobutyl acrylate. Applicants have found that this polymer gives various beneficial properties when incorporated into lipsticks and similar cosmetics.

3. The state and level of predictability of the prior art

The prior art recognizes that the Tg of a polymer depends on many factors, including the polymer's molecular weight, environment, and chemical composition. However the exact nature of these relationships, however, is not clear. For example, the Nojiri reference indicates that, according to one theory, the Tg of polymer depends on a variety of constants relating to the structural makeup of the polymer and is inversely related to the molecular weight. But Nojiri notes that in some experiments where polymers are exposed to air and water, Tg may be inversely related to the square of the molecular weight. Sot there is an unresolved dispute in the art as to when Flory theory (inverse linear relationship) matches empirical data.

Further, Erichsen indicates that the Tg of a styrene sample differ depending on whether the Tg is measured at the surface or in the bulk mass. To make matters more confusing, Erichsen indicates that the degree of this difference varies based on molecular weight. The difference is pronounced ar some molecular weights and undetectable at other molecular weights.

Also, the art does not recognize any connection between the chemical structure of a polymer and the Tg so that the effect of structure on the Tg can be determined without experimentation.

For these reasons, the art is highly unpredictable. There is no way for the artisan to know what Tg a particular polymer structure might have, especially considering that molecular weight and polymer environment alter the Tg in unpredictable ways.

4. The level of ordinary skill

The applicable field of art is chemistry. The ordinary artisan works in the field of polymer or cosmetics formulation, and has a bachelors degree in chemistry, or a similar combination of education and experience. C.f. *C&EN* article (more than 5 times more bachelor degrees than Ph.D. degrees in chemistry awarded each year). Thus, the artisan can follow standard operating procedures, optimize known methods, and apply standard operating procedures to systems that are marginally different from those already known. But it is beyond the skill of the artisan to come up with new operating procedures, or even to apply old procedures to highly unfamiliar systems.

5. The direction provided by the inventor and the working examples

The sole working example is the elected polymer, which is not included inthis rejection. Other than the working examples, the disclosure's only "direction" is in the form of "laundry lists" of monomers and ingredients that may, or may not, give a polymer that has the claimed properties.

6. The quantity of experimentation required

In order to make the invention, the artisan would have to start from scratch, using trial and error experimentation in an attempt to uncover a polymer that had the requisite Tg properties. The artisan would have to determine not only the correct chemical structure of the various ingredients, but also the appropriate molecular weights and appropriate amount of diluents, additives, and the like.

Given the modest abilities of the ordinary artisan, and the high degree of unpredictability in this art, the required experimentation would be undue.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8-22, 24-26, and 68-120 of copending Application No. 10/949435. Although the conflicting claims are not identical, they are not patentably

distinct from each other because instant claims allow for any "cosmetically acceptable organic liquid medium" whereas copending claims require the medium to be a "no-volatile liquid fatty phase." Because copending claims are a species of instant claims, they render instant claims obvious in their entirety.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 of copending Application No. 10/529265. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the two applications use different language, but cover substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 87-89, 91, 93-142, 144-153, and 155-181 of copending Application No. 10/529267. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the two applications use different language, but cover substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10-59 of copending Application No. 10/573579 Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims require a tensioning agent, which is not required by instant claims. Instant claims, however, use open-ended language and may include the tensioning agent. Thus copending claims are a species of instant claims and render instant claims obvious in their entirety.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-88 of copending Application No. 10/585818. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending independent claim does not require a liquid medium, dependent copending claims require this.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 8, 18, 26, 27, 29, 35, 73, 75, 78, 81-89, and 87-89 of copending Application No. 10/670478 in view of US 2006/0093568. The '478

application claims the polymer used in these claims, but does not claim the polymer combined with the liquid medium. The '568 reference teaches the use of the polymer of the '478 application in cosmetically acceptable liquid medium. Combining the two references would be a matter of following the express suggestion of '568.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,6,8-57,59,60,and 62-104 of copending Application No. 11/086906. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the two applications use different language, but cover substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-106 of copending Application No. 11/089210. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending independent claim does not require the polymer of instant claim, dependant copending claims such as claim 4 include this requirement.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-121 of copending Application No. 11/858994 in view of US 2006/0093568. The '994 application claims the polymer used in these claims, but does not claim the polymer combined with the liquid medium. The '568 reference teaches the use of the polymer of the '994 application in cosmetically acceptable liquid medium. Combining the two references would be a matter of following the express suggestion of '568.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-121 of copending Application No. 11/859004 in view of US 2006/0093568. The '004 application claims the polymer used in these claims, but does not claim the polymer combined with the liquid medium. The '568 reference teaches the use of the polymer of the '004 application in cosmetically acceptable liquid medium. Combining the two references would be a matter of following the express suggestion of '568.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being

unpatentable over claims 92-121 of copending Application No. 11/859015 in view of US 2006/0093568. The '015 application claims the polymer used in these claims, but does not claim the polymer combined with the liquid medium. The '568 reference teaches the use of the polymer of the '015 application in cosmetically acceptable liquid medium. Combining the two references would be a matter of following the express suggestion of '568.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 65-69, 71, 72, 74, 76, 78-147 of copending Application No. 10/528698. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the two applications use different language, but cover substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 77-80, 83-94, 97-107, 109-161 of copending Application No. 10529266 in view of US 2006/0093568. The '266 application claims the polymer used in these claims, but does not claim the polymer combined with the liquid medium. The '568 reference teaches the use of the polymer of the '266 application in cosmetically

acceptable liquid medium. Combining the two references would be a matter of following the express suggestion of '568.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 80-83, 86, 87, 90-140, 142-176 of copending Application No. 10/529218. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending claim 80 does not require that the polymer be free of styrene, but copending claim 81 requires no styrene, thereby making up for this deficiency.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 67-129 of copending Application No. 10/529264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims require a specified transfer resistance, whereas instant claims are generic to this property. Thus copending claims are a species of instant claims, rendering instant claims obvious in their entirety.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 95-101 and 10—216 of copending Application No. 10/529318. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims require a plasticizer, whereas instant claims are generic to this property. Thus copending claims are a species of instant claims, rendering instant claims obvious in their entirety. Further, the independent copending claim does not require the same Tg of the various polymer blocks as the instant independent claim, but dependant copending claims include this limitation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 of this application conflict with claims 65-69, 71, 72, 74, 76, 78-147 of Application No. 10/528698. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 of this application conflict with claims 10—112, 15, 116, 119-168, and 170-220 of Application No. 10/529265. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 of this application conflict with claims 87-89, 91, 93-142, 144-153, and 155-181 of Application No. 10/529267. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 of this application conflict with 1,2,6,8-57,59,60,and 62-104 of copending Application No. 11/086906. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC E. SILVERMAN whose telephone number is (571)272-5549. The examiner can normally be reached on Monday to Thursday 7:00 am to 5:00 pm and Friday 7:00 am to noon.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/
Primary Examiner, Art Unit 1618